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**BRINKS
HOFER
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& LIONE**

Our Case No. 659/1143
K-C Ref. No. 19,226

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Van Gompel, et al.

Serial No.: 10/624,660

Filing Date: July 22, 2003

For: DISPOSABLE UNDERGARMENT
HAVING A CUTOUT AND
METHOD FOR THE
MANUFACTURE THEREOF

Examiner: Craig, Paula L.

Group Art Unit No.: 3761

**PETITION UNDER 37 CFR 1.181 AND 1.144 TO REVIEW RESTRICTION
REQUIREMENT**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Statement of Facts:

The Examiner mailed an Election/Restriction requirement on December 6, 2006, wherein the Examiner identified ten (10) species and instructed Applicants to "elect a *single* disclosed species" (December 6, 2006 Office Action at 3) (emphasis added). In response, Applicants elected Species G and stated that claims 1-8, 10-16 and 28-33 were either generic with respect to, or read on, Species G (Response to Restriction Requirement file January 8, 2007). Notwithstanding Applicants' election, and the fact that the Examiner previously examined claims 1-16 and 28-31 on the merits after making a first restriction/election

requirement in an Office Action mailed March 23, 2006, apparently without undue burden, the Examiner considered only claims 1 and 8 in an Office Action mailed March 27, 2007.

In response, Applicants initiated a telephone interview with the Examiner on April 11, 2007 to discuss the Examiner's decision not to examine claims 2-7, 10-16 and 28-33. In particular, Applicants explained that every one of claims 2-7, 10-16 and 28-33 reads on the elected Species G. During the interview, the Examiner did not substantively dispute that the noted claims did in fact read on Species G, but instead invited Applicants to traverse this decision in writing (see also Interview Summary mailed April 16, 2007). Accordingly, Applicants filed an Amendment After Final and Written Statement As To Substance of Interview on June 4, 2007, wherein Applicants respectfully requested that the Examiner reconsider her decision to examine only claims 1 and 8, and instead examine all of the claims that are generic with respect to, or read on, elected Species G.

In an Advisory Action mailed June 28, 2007, the Examiner refused to consider the additional claims on the merits. Pursuant to 37 CFR 1.144, and now having asked for reconsideration, which was denied, Applicants hereby petition the Director to review the restriction requirement.

Action Requested:

Applicants request one of two alternative actions in response to this Petition:

1. The Examiner should examine claims 2-7, 10-16 and 28-33 on the merits; or
2. The Examiner should provide a new restriction requirement wherein the Examiner designates five (5) categories of species, wherein Applicants could elect one species from each category (e.g., (1) species A and B; (2) species C and D; (3) species E and F; (4) species G and H; and (5) species I and J).

Argument:

As explained by Applicants during the April 11, 2007 interview, it is important to remember that "the scope of a claim may be limited to a single disclosed embodiment (i.e., a

single species, and thus be designated a specific species claim), or a claim may include two or more of the disclosed embodiments within the breadth and scope of the claim (and thus be designated a generic or genus claim)” (MPEP 806.04(e)). One must be careful, however, not to fall into the trap of designating claims as species (see, e.g., December 6, 2006 Office Action at 2-3, describing each Species as “disclosed” or “exemplified” by one or more claims). The long established rule is that “claims are never species” (MPEP 806.04(e) (emphasis in original)). Rather, species are different embodiments (*Id.*). In the present case, claims 1-8, 10-16 and 28-33 each read on, or are generic with respect to, elected Species G. Indeed, claim 9 is the *only* claim that does not read on the elected Species G.

During the interview, Applicants further discussed with the Examiner the possibility that perhaps she intended to designate five (5) categories of species, wherein Applicants could elect one species from each category (e.g., (1) species A and B; (2) species C and D; (3) species E and F; (4) species G and H; and (5) species I and J). Indeed, whether a crotch member is connected to a body side or garment side of a body panel web (Species G and H) has nothing to do with, and are not different “species” with respect to, the shape of a cutout (Species C and D). As such, claims that specifically target, for example, the subject matter of Species C and D *are not limited in scope* with respect to Species G and H.

In the present case, however, the Examiner expressly requested Applicants to elect a “single” designated species from the list of ten (A-J). Applicants should not now be punished by way of limited examination when clearly a great number of claims (all but claim 9) withdrawn by the Examiner *read on the elected species G*. Indeed, under the present restriction scheme proposed by the Examiner, Applicants arguably will be required to file 20 different applications to obtain protection for the claimed inventions (two Groups (I and II), each having ten (A-J) species). Such a scheme is not proper, and unnecessarily squanders the resources of Applicants and the Patent Office.

Applicants further point out the Examiner had already examined claims 1-16 and 28-31 in the prior Office Action. Although the Examiner argues that the scope of claim 1 changed due to amendments filed September 11, 2006 and June 4, 2007 (see Advisory Action), Applicants submit that the Amendment of September 11, 2006 is not related to the restriction requirement. Indeed, the Examiner stated that amended claim 1 was *generic* with

respect to the species designations. Moreover, the June 4, 2007 amendment was not entered, and has no bearing on the restriction requirement.

Finally, Applicants respectfully submit that the Examiner has refused to examine certain claims that are generic with respect to *all* of the designated species. For example and without limitation, Applicants submit that at least independent claim 10 is generic with respect to all of the designated species. Applicants respectfully submit that a more complete examination is required on this basis alone.

In summary, Applicants respectfully petition and request that the Examiner examine claims 2-7, 10-16 and 28-33 on the merits, or provide a new restriction requirement wherein the Examiner designates five (5) categories of species, wherein Applicants could elect one species from each category (e.g., (1) species A and B; (2) species C and D; (3) species E and F; (4) species G and H; and (5) species I and J). The Director is hereby authorized to charge payment of any fees associated with this petition to Deposit Account No. 23-1925.

Respectfully submitted,



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